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To: Examiner Collins  
 From: Kristi Rupert  
 Fax: 703/340-5032  
 Pages: 8  
 Phone: Date: 12-30-03 1-2-04  
 Re: 09/09/03, 719  
 CC:

Urgent  For Review  Please Comment  Please Reply  Please Recycle

## Comments:

Response filed 6-6-03

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 ATTY: Ginn, Kuk  
 APPLICANT: YOKO, NAKAJIMA et al.  
 USN: 09/07/03 FILED: Oct. 27, 2010  
 PAT. NO.:

New Application with Transmittal Letter  
 Utility  Design  CIP  PCT  Provisional  
 Filing Under 37 CFR 1.53(b)  CONT  DIV  
 Filing Under 37 CFR 1.53(d) (CPA)

Specification Consisting of: \_\_\_\_\_ pages

Combined Declaration & Power of Attorney

Assignment / Cover Letter

Letter to Official Draftsman

Drawings \_\_\_\_\_ Sheets  Formal  Informal  Red-Link

Completion of Filing Requirements, PCT/ID/04/0905  
 or PTO-1533 and Executed Declaration  
 Priority Document(s) / Cover Letter, No. Doc. \_\_\_\_\_

Amendment

Trans and Lit  Large Entity  Small Entity  
 Response

Information Disclosure, PTO-1449(s) \_\_\_\_\_ doc(s)

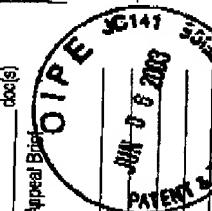
Notice of Appeal

Issue Fee Transmittal

FEES

Letter

Offer



Receipt is hereby acknowledged of the above document filed as  
 indicated in connection with the above identified case.  
 COMMISSIONER FOR PATENTS AND TRADEMARKS  
 Due Date: 09/07/03  
 Handcarry: \_\_\_\_\_

JAN 05 2004

**OFFICIAL** PATENT  
0020-4764P

## IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Hiroki NAKAJIMA et al. Conf.: 4838

Appl. No.: 09/697,719 Group: 1638

Filed: October 27, 2000 Examiner: COLLINS

For: METHOD FOR GIVING RESISTANCE TO WEED  
CONTROL COMPOUNDS TO PLANTSLARGE ENTITY TRANSMITTAL FORMCommissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

June 6, 2003

Sir:

Transmitted herewith is a Reply to Restriction/Election  
Requirement in the above-identified application.

- The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.
- Petition for ( ) month(s) extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). \$0.00 for the extension of time.
- No fee is required.
- A check in the amount of \$0.00 is enclosed.
- Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this sheet is attached.

Appl. No. 09/697,719

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By   
Gerald M. Murphy Jr., #26,977

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Falls Church, VA 22040-0747  
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*MR*  
GMM/KLR:gml  
0020-4764P

Attachment(s)

(Rev. 04/30/03)

PATENT  
0020-4764P

## IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Hiroki NAKAJIMA et al. Conf.: 4838  
Appl. No.: 09/697,719 Group: 1638  
Filed: October 27, 2000 Examiner: Collins  
For: METHOD FOR GIVING RESISTANCE TO WEED CONTROL  
COMPOUNDS TO PLANTS

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

June 6, 2003

Sir:

In response to the Office communication dated May 7, 2003, the following remarks are respectfully submitted in connection with the above-identified application.

Application No. 09/697,719

REMARKS

Claims 1-69 are pending in the present application. No new matter is inserted into the application.

**Restriction Requirement**

In response to the Restriction and Election Requirement, Applicants elect Group VI, claims 1-7, 20-25, 28-31, 37, 43, 45, 47, 49, and 51, drawn to a method of producing a herbicide resistant plant comprising transforming a plant with a polynucleotide encoding a protoporphyrinogen IX oxidase protein derived from soybean and lacking the ability to oxidize protoporphyrinogen IX, a plant produced therefrom and methods of using said plant, with traverse.

Applicants respectfully submit that the Examiner has not established that there is an *undue burden* in searching for all claims as required by MPEP § 803. The "undue burden" requirement created by the U.S. Patent and Trademark Office is recited in MPEP § 803:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on its merits, even though it includes claims to independent and distinct inventions.

The Examiner states, "the search required for one of the groups is not required for another..." On the other hand, the Examiner

Application No. 09/697,719

states that all of the claims are classified within the same class, (i.e., class 800). The groups only differ by subclassification, but even then, Groups I, II, VIII, IX, XI, XII, and XIII share the same subclassification of subclass 300, Groups III, IV, and V share the same subclass of 288, and Groups VI, VII, and X share the same subclass of 278. Applicants do not believe that an undue burden would be placed on the Examiner to rejoin the claims, especially when the claims share the same classification.

For these reasons, Applicants believe that an undue burden for searching does not exist, and respectfully request that the Examiner rejoin all claims of the present invention and examine them together in the present application. In particular, Applicants respectfully request that the Examiner rejoin the claims of Groups VI and VII, based upon their identical subclassifications. This rejoinder would only require the addition of claims 26 and 27 to the claims of Group VI. Applicants do not believe that an undue burden would be placed on the Examiner to add two claims to the elected claim set.

An early and favorable action on the merits of the present application is earnestly solicited.

If the Examiner has any questions concerning this application, the Examiner is requested to contact Kristi L. Rupert, Ph.D. (Reg. No. 45,702) at (703) 205-8000.

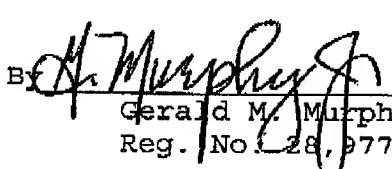
Application No. 09/697,719

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By

  
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